

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed March 3, 2008, has been entered. Claims 1, 33-36, and 50 have been amended as requested. Claims 12-20, 25, 26, 31, 32, 37, 40, 41, and 44-49 have been cancelled, while new claims 51-55 have been added. Thus, the pending claims are 1-11, 21-24, 27-30, 33-36, 38, 39, 42, 43, and 50-55.
2. Said amendment is sufficient to withdraw the 103 rejection of claims 1-11, 21-24, 27-30, 38, 39, 42, and 43 as set forth in sections 5 and 6 of the last Office Action (Non-Final Action mailed 10/02/07). See new 112 rejections of said claims set forth below. Additionally, the 103 rejection of claims 33-36 and 50 is hereby withdrawn due to the claims being limited to floor tiles. Note, in said rejection, the primary reference of Lukowski is not drawn to tiles. However, a new prior art rejection necessitated by amendment is set forth below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-11, 21-24, 27-30, 38, 39, 42, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 1 is drawn to a surface covering element comprising a show surface,
“wherein the show surface comprises a surface selected from the group consisting of

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vinyl, ceramic, laminate, and wood” and “wherein the surface covering element is a cushion back carpet tile.” Hence, it is unclear how the show surface can be both a carpet and one of vinyl, ceramic, laminate, and wood. Claims 2-11, 21-24, 27-30, 38, 39, 42, and 43 are rejected for their dependency upon indefinite claim 1.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-11, 21-24, 27-30, 38, 39, 42, and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not enable a surface covering element having a show surface which is simultaneously both a carpet and one of vinyl, ceramic, laminate, and wood. Thus, said claims are rejected as containing new matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 33-36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/07785 issued to Nygaard et al. in view of US 2003/0198795 issued to Grant and US 2004/0258874 issued to Desai.

Nygaard discloses a carpet tile having an anti-slip, adhesive backing extending over the underside thereof (abstract). The adhesive is chosen so as to a greater adhesive power between the carpet backing and said non-slip layer than between said non-slip layer and a floor that is to be covered (page 4, lines 5-11). This insures that the adhesive does not remain behind on the flooring which has been covered (page 4, lines 11-14). Additionally, said adhesive is chosen so that the adhesive power between the anti-slip layer and the floor is greater than the suction force of an industrial carpet cleaning apparatus, thereby preventing loosening of said carpet tiles during cleaning. Furthermore, said adhesive is selected so that two carpet tiles can be releasably adhered to each other by the anti-slip layers for packaging (page 4, lines 26-31 and Figures 2 and 3). Upon installation of the carpet tiles, the non-slip layer prevents said tiles from shifting during use (page 6, lines 16-37).

Thus, Nygaard teaches surface covering elements that are floor tiles, wherein said tiles have a “friction enhancing coating composition” coated on the underside. Nygaard fails to teach that floor tiles may be comprised of a vinyl, ceramic, laminate, or wood surface rather than a carpet surface. However, floor tiles other than carpet having similar constructions are well known in the art. For example, it is well known that modular tiles for covering floors, walls, and ceilings may comprise various decorative surfaces, such as ceramic, vinyl, metal, and wood. Note Grant which teaches modular surface coverings include carpet tiles, ceramic panels and tiles, and vinyl materials (abstract). Additionally,

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Desai teaches various decorative surfacing materials, such as carpet, wood, plastic, ceramic, vinyl, or laminate, may be employed for tiles of a like inventive backing construction (abstract and section [0002]). Thus, it would have been obvious to one skilled in the art to substitute another known surfacing material, such as ceramic, vinyl, laminate, or wood, as taught by Desai and Grant for the carpet layer of the Higgins references since the equivalence of the various decorative surfaces and carpet as surface coverings is well-known in the art. As such, the choice of any of these equivalents is within the level of ordinary skill in the art, especially since any selection thereof would have yielded predictable results.

Regarding the underside of PVC, while the prior art fails to explicitly teach PVC backings for the various floor tiles, applicant is hereby given Official Notice that PVC, in both a hardback and cushion form, is a common backing material for floor tiles. [The examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.] Hence, all the elements of the present claims are known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in the respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Therefore, claims 33-36 and 50 are rejected as being obvious over the prior art.

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10. Claims 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Nygaard, Grant, and Desai references in view of US 3,847,647 issued to Bahlo.

While Nygaard, Grant, and Desai fail to teach application of the friction enhancing coating in a discontinuous pattern, it is well known in the art to apply adhesive coatings to carpet tiles in discontinuous patterns. For example, Bahlo discloses an adhesive backed removable carpet tile comprising a foam backing and a carpet layer (abstract). "To provide the proper release strength, the adhesive is applied to the foam backing by a figured roller to cover between 10 and 50 percent of the foam backing." (abstract and Figures 1 and 3). Therefore, it would have been readily obvious to one of ordinary skill in the art apply the adhesive coating in a discontinuous pattern in order to reduce cost and/or to achieve the proper adhesive strength. Hence, claims 51-55 are also rejected.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Juska/
Primary Examiner
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cj
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